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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/586,017	10/26/2006	Gregg D. Scheller	54084-62558	9314
21888 7590 10/21/2010 THOMPSON COBURN LLP ONE US BANK PLAZA SUITE 3500 ST LOUIS, MO 63101				
EXAMINER FARAH, AHMED M				
ART UNIT		PAPER NUMBER		
3769				
NOTIFICATION DATE		DELIVERY MODE		
10/21/2010		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

IPDOCKET@THOMPSONCOBURN.COM

# Office Action Summary

**Application No.**

10/586,017

**Applicant(s)**

SCHELLER, GREGG D.

**Examiner**

Ahmed M. Farah

**Art Unit**

3769

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 24 September 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 9-16 is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☒ Claim(s) 6-8 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/22)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date 9/22/09 and 9/25/09

## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Easley et al. US Patent No. 5,356,407 in view of Murphy-Chutorian et al. US Patent No. 5,855,577.

Easley et al. disclose a surgical instrument that provides both illumination light and laser light to a surgical site, the surgical instrument comprising:

a manipulatable handle **19** (see Fig. 1);

a tubular tip **25** secured to the handle **19**, the tip projecting from the handle to a distal end of the tip;

an illumination optic fiber **18** having a length with opposite proximal and distal ends, the illumination optic fiber extending through the handle **19** and the tip **25** to the illumination optic fiber distal end positioned adjacent the tip distal end, the illumination optic fiber being secured stationary relative to the tip (see Figs. 3 and 4); and

a laser optic fiber **17** having a length with opposite proximal and distal ends, the laser optic fiber extending through the handle **19** and the tip **25** to the laser optic fiber

distal end positioned adjacent the tip distal end and the illumination optic fiber **18** distal end (see Figs. 3, 4, and col. 4, lines -9).

Easley et al. do not teach a mechanism on the handle that is configured to move either of the optical fibers through the handle and the tip between retracted position and extended positions as claimed. However, the use of a mechanism for moving a light delivery optical fiber between retracted and extended positions through a surgical probe is known in the art.

Murphy-Chutorian et al. disclose catheter apparatus and method of use, the catheter comprising: an instrument handle **128**; a tubular sleeve (catheter shaft **102**) projecting from the instrument handle **128**; an optical fiber **120** extending through the handle and the sleeve to a distal end portion that projects from the sleeve; and a mechanism **144** on the handle **128**, which is configured to selectively moves the optical fiber between retracted position and an extended position as claimed.

Hence, at the time of the applicant's invention, it would have been obvious to one of ordinary skill in the art to modify Easley et al. in view of Murphy-Chutorian et al. and use a mechanism configured to move the laser delivery optical fiber between a retracted position and an extended position as claimed. Moving the optical fiber in a retracted position within the sleeve of the tubular tip when the probe is not in use would protect the integrity of the optical fiber. It would also enhance the safety of the surgical procedure by preventing un intended damage/puncturing of the patient's body in the instance where the probe is used for insertion into a portion of the patient's body, such as the eye, blood vessel, etc.

***Allowable Subject Matter***

Claims 9-19 are allowed.

Claims 6-8 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Esch et al., US Patent No. 5,469,524, disclose an endoscopic treatment apparatus comprising: a handle **13**; a probe tip **21** attached to the distal end of the handle **13** (see Fig. 1); a treatment light source and control means **57**; an illumination light source **27**; illumination light and treatment light delivery optical fibers **23, 25** (see Fig. 2); and a mechanism **41** configured to move a sleeve **45** over the treatment optical fiber between a retracted position and an extended position, such that (1) when the sleeve is in the retracted position the optical fiber projects from the distal of the probe, and (2) when the sleeve is in the extended position, the optical fiber is inside the lumen of the sleeve.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ahmed M. Farah whose telephone number is (571) 272-

4765. The examiner can normally be reached on Mon, Tue, Thur and Fri between 9:30 AM 7:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johnson Henry can be reached on (571) 272-4768. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Ahmed M Farah/  
Primary Examiner, Art Unit 3769

August 14, 2010.